

have been obvious to use a plastic wire for the device of Brannon. The Office Action did not address the videotape submitted in response to the very first office action, showing that the unusual and unobvious traits of using plastic wire for such a coil in the invention. Indeed, the Office Action did not address or show any prior art showing the existence of a singular coiled piece, having an integral handle.

The Office Action also stated that the phrase "consisting essentially of" does not exclude the hoop, the shank, the clam, the rod and the clip or any of the other features of Brannon. The Office Action went on to state that the phrase was or could be interpreted as equivalent to "comprising."

In response, on December 15, 2005, applicant filed a Response to the Office Action. In that response, applicant argued:

Brannon has no handle which is part of a single, unitary [plastic] wire. In fact, there appears to be no handle at all. The handle as described in the claims of the present invention is critical for the ability to whip the spring part of the device so that it extends, allowing the device to wrap around the "object of desire." **The handle as described in the present invention is specifically described such that it has no bearing to the handle of Brannon.** In place of the handle described in the present invention, Brannon has a clamp connected to a shank, which in turn is connected to a shank housing, which is further connected to a passing clip. There is no single, unified plastic piece which has **both** a coil and a handle in one unitary structure, nor is there a suggestion or teaching of such a device.

Second, this toy must be made out of plastic. It would not function if

made out of metal. The Office Action states that it is well known to make such a wire out of metal. The Office Action is missing the point. This invention is a composition with a purpose or function. The plastic gives this device an elasticity that one does not have when using metal. The whole purpose of submitting a videotape of the use of the invention was so that there would be an understanding of the relation between the material and the invention, and understand the criticality of the use of plastic as a critical element of the invention. Similarly, a review of the videotape would have shown why the use of plastic, and the construction of the handle as designed, differentiate the present invention from the prior art.

Applicant also argued in part:

Brannon has no handle which is part of a single, unitary [plastic] wire. In fact, there appears to be no handle at all. The handle as described in the claims of the present invention is critical for the ability to whip the spring part of the device so that it extends, allowing the device to wrap around the "object of desire." **The handle as described in the present invention is specifically described such that it has no bearing to the handle of Brannon.** In place of the handle described in the present invention, Brannon has a clamp connected to a shank, which in turn is connected to a shank housing, which is further connected to a passing clip. There is no single, unified plastic piece which has **both** a coil and a handle in one unitary

structure, nor is there a suggestion or teaching of such a device.

The applicant thereupon amended the application so that the phrase "consisting essentially of" was changed to "consisting of" in response to the comments of the Office Action.

In response to the Response After Final, applicant received an Advisory Action Before the Filing of Appeal Brief. The Advisory Action stated:

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:

(a) They raise new issues that would require further consideration and/or search:

(c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal;

7). For purposes of appeal the proposed amendment(s) a) will not be entered.

On March 8, an RCE was filed, along with the appropriate fees and extensions.

On June 6, 2006 a first Office Action was issued which was made final.

I) THE FIRST OFFICE ACTION SHOULD NOT HAVE BEEN MADE FINAL

A) FINAL REJECTION IMPROPER UNDER 706.07(B)

MPEP 706.06(b) states:

> [I]t would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, (B) the issue of new matter was raised.

As noted above, the amendment and response after Final was rejected as offering new matter. This runs counter to the rule(s) as set forth in the MPEP

B) APPLICANT WAS ADDRESSING NEW ISSUES RAISED IN THE FINAL OFFICE ACTION OF DECEMBER 10, 2005.

If new issues or comments are raised by the Final Office Action of December 10, 2005, and applicant merely responds to said Office Action to rectify the alleged issues in the application, then a Final Office Action on a First Office Action is not proper.

C) THE CITATION OF "NEW" PRIOR ART

New prior art is cited in the most recent Office Action. This infers that new arguments are

being put forth in the Office Action, which requires a new response. This in and of itself indicates that there should have been no Final Action.

II) THE OFFICE ACTION FAILS TO READ THE CLAIM IN ITS ENTIRETY

Claim 22 reads as follows:

22) (currently amended) A flexible, retractable coiled toy consisting of:

a single, unitary plastic wire having a circular cross section and having memory, said wire comprising:

- i) a helical section, said helical section ranging in length from about two and three-quarter inches to about six inches. and
- ii) a handle, said handle being integral with said helical section, said handle comprising a straight section of said wire extending outwardly from said helical section wherein said handle ranges in length from about 3 ½ inches to about 6 ½ inches.

It is important to emphasize that the claim states that the coiled toy is a **single, unitary** plastic wire. The present and past Office Actions have treated the present invention as if the handle of the wire was a separate piece of the device. It is not. Brannon does not teach a handle that is actually part of the coil, and certainly not a handle that is consists of part of the wire.

The Office Action refers to a "straight" section in the figure 1. It is unknown how long this structure is, what is the nature of the structure, etc. No discussion is given.

Additionally, there are other fundamental differences between the two items

III) HINDSIGHT CAN NOT BE USED TO CREATE THE INVENTION

Applicant's invention has unique properties, given its size, shape, structure and material (plastic) from which it is made. No other individual created such a device, and, in fact, the device is now being infringed by others in the entertainment industry.

There has never been any acknowledgment in the Office Action(s) that the videotape that was twice submitted to this file has been reviewed. Had it been reviewed, the unique properties of the invention would have been seen.

Instead, hindsight has been used to pull pieces of several pieces of prior art to create said present invention. Both the CCPA and the Federal Circuit have stated that 20/20 hindsight can not be used by the U.S. Patent and Trademark Office to create an invention so as to make the invention in issue obvious.

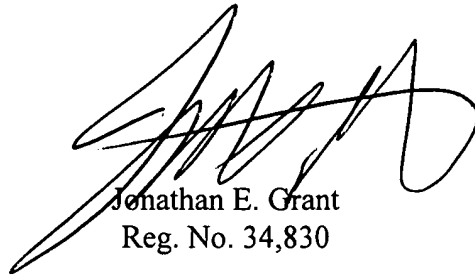
Yet, that is precisely what has been done here. An examination of the multitude of Office Actions shows that "new" prior art has constantly been cited, even as "old" prior art was overcome, in an attempt to defeat this invention.

An interview is requested in this case.

This application is now in condition for allowance. If there are any questions, please call the undersigned at (301) 603-9071 or (301) 346-8714.

Thank you.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jonathan E. Grant', with a large, sweeping flourish at the end.

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